

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Applicants : Robert E. Boyd and James A. Forsyth
Appln. No. : 10/686,353
Filed : October 14, 2003
Title : INSOLE HAVING MULTIPLE ENERGY SOURCES
Docket No. : 066491-00007
Art Unit : 3728
Examiner : Mohandes

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.131

We, Robert E. Boyd and James A. Forsyth, the inventors of the subject matter presented in the above-identified patent application, declare and say:

1. This declaration is being made to establish invention of the subject matter of the rejected claims in the above-identified patent application prior to the effective date of U.S. Patent No. 7,020,988 to Holden et al. The effective date of U.S. Patent No. 7,020,988 under 35 U.S.C. 102(e) is August 29, 2003. The activities described below took place within the United States, and no activities taking place in any country

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other than the United States, a NAFTA country, or a WTO member country form the basis of our claim to prior invention.

2. Provided in Appendix A is a copy of a patentability search request dated prior to August 29, 2003 and prepared on our behalf which describes the physical construction and relative rebound properties of an insole such as that claimed in independent claims 1 and 27 of the presently pending application.
3. Provided in Appendix B is a copy of a letter dated prior to August 29, 2003 by the first named inventor authorizing the preparation of a patent application for an insole having two elastomer pads including the hardness and rebound ranges recited in claims 1-3, 27, and 32-33 of the presently pending application.
4. Provided in Appendix C is a copy of a letter dated prior to August 29, 2003 by the first named inventor providing further information including the preferred hardness ranges that are recited in claims 8-9 and 38-41 of the presently pending application.
5. We, the inventors, conceived of the invention recited in the cited claims prior to August 29, 2003. The materials provided in Appendices A-C serve to corroborate a date of conception prior to the effective date of U.S. Patent No. 7,020,988 to Holden et al.
6. Provided in Appendix D is a copy of a letter to a third party dated prior to August 29, 2003 and enclosing a sample of a product embodying the invention of at least independent claim 1, described therein as an "Ultra Sole utilizing spring gel in the forefoot."

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7. Provided in Appendix E are copies of business records documenting sales of a product embodying the invention of at least independent claim 1, marketed as the "NRG Ultra Sole," comprising: (page 1) a factory order dated July 21, 2003 for 6600 units; (page 2) a picking ticket documenting shipment of 200 units on July 21, 2003; (page 3) an invoice billing the shipment released on July 21, 2003; (page 4) a picking ticket documenting shipment of 4725 units on July 31, 2003; and (page 5) an invoice billing the shipment released on July 31, 2003.
8. We, the inventors, reduced the claimed invention to practice on or before July 21, 2003 through sales of an embodiment of the invention to an unrelated third party. The materials provided in Appendices A-E serve to corroborate conception of the invention prior to the effective date of U.S. Patent No. 7,020,988 coupled with an actual reduction to practice prior to August 29, 2003.
9. Provided in Appendix F is a copy of a letter dated September 5, 2003 enclosing a draft patent application for review by the named inventors.
10. Provided in Appendix G is a copy of a letter dated October 8, 2003 by the first named inventor, on behalf of both inventors, approving the draft application received with the letter included in Appendix F and ordering the filing of the above-indicated patent application.
11. We, the inventors, acted with due diligence from prior to August 29, 2003 to the filing of the above-identified patent application on October 14, 2003. This diligence included ordering the preparation of a patent application, reviewing the draft patent application, and ordering the filing of the approved draft patent application. The materials provided in Appendices A-G serve to corroborate conception of the

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invention prior to the effective date of U.S. Patent No. 7,020,988 coupled with due diligence from prior to August 29, 2003 to the filing of the above-identified patent application.

12. We, the inventors, further declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Robert E. Boyd

Robert E. Boyd

6-13-07

Date

James A. Forsyth

James A. Forsyth

6-13-07

Date

449591.1

DECLARATION UNDER 37 C.F.R. § 1.131

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Appendix A

LEGIS TOWER
SUITE 1100
15 MUNSON STREET, NW
CANTON, OHIO 44718-3615

TELEPHONE: (330) 244-1174
FAX: (330) 244-1173
EMAIL: INFO@SANDSEBOLT.COM

SAND & SEBOLT
A LEGAL PROFESSIONAL ASSOCIATION

PATENT, TRADEMARK, COPYRIGHT LAW
& RELATED LITIGATION

JOSEPH A. SEBOLT
FREDERICK H. ZOLLINGER, III
LAURA L. BEOGLOS
CLAY H. CUNNINGHAM

MICHAEL SAND
JAMES F. McCARTHY, III
Of Counsel

RE: Patent Search
INSOLE HAVING MULTIPLE
ENERGY SOURCES

Dear [redacted]:

Our client would like to conduct a patentability search for an insole product having multiple energy components. Most notably, the unit would provide an insole having an elastomer, which would not be foam, with a first spring rate, and then tailored to the type of sport for which the insole will be used, a second more energy absorbing spring rate will be provided. The second energy absorbing spring rate material could be provided adjacent the heel or the ball of the foot to take impact from a runner, or along the side of the insole to take impact from side load as a result of movements during the sport of tennis. Additionally, a device could be provided having an impact absorbing material with a low spring rate, and therefore very impact absorbing at the heel of a runner's insole, and a material with a high spring rate adjacent the ball of the user's foot to urge the user's foot upwardly after impact, causing the runner to experience less weight load during running, while simultaneously allowing the insole to absorb high impact at heel load. The elastomers would normally be of a gel or semi-gel type, and would be mounted within a carrier manufactured of any elastomer foam or fabric such as shown on the attached sheet.

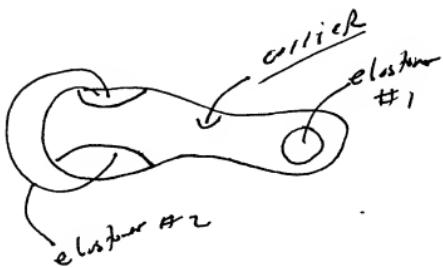
Yours truly,

SAND & SEBOLT


By: Joseph A. Sebolt

JAS/tmg
Encl.

From the desk of Joe Sebolt ...



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Appendix B



[REDACTED]

[REDACTED]

Joe Sebolt
SAND & SEBOLT
Aegis Tower
4940 Munson St. N.W., Suite 1100
Canton, OH 44718

SUBJECT: Multi Elastomer Insole

Dear Joe,

[REDACTED]

I would suggest that you use our patent number 4808469 as a guide in comprising the elements you feel necessary to seek patent approval on this new insole product.

Suggested name: Multi-gel Elastomer Composite Insole

Insole is to be comprised of two or more elastomers with different rates of energy absorbing properties and/or rebound properties.

Elastomer #1 having a density from .7 to 2.0 and a durometer ranging from 20 to 70 durometer, shore 00 scale and having a rebound rate 1% to 40%.

Elastomer #2 having a density from .8 to 2.2 and durometer range from 30 to 70 durometer, shore 00 scale and having a rebound rate from 5% to 90%.

The intent of the composite insole is to absorb energy in designated areas of the foot and return energy in designated areas of the foot, at varying rates.

[REDACTED]

Sincerely,

SORBOTHANE, INC.

A handwritten signature in black ink that appears to read "Boyd".

Robert E. Boyd
President

Cc: Jim Forsyth

Sorbothane Inc.
Innovations in Advanced Polymer Technology

2144 State Rt. 59 • Kent, Ohio 44240 • www.sorbothane.com
800-838-3906 • Phone (330) 678-9444 • Fax (330) 678-1303

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Appendix C



[REDACTED]

Joe Sebolt
SAND & SEBOLT
Aegis Tower
4940 Munson St., N.W., Suite 100
Canton, OH 44718

[REDACTED]

SUBJECT: Multi Elastomer Insole

Dear Joe,

[REDACTED]

[REDACTED] you could change the durometer range on Elastomer #1 to read having a density of .7 to 2.0 and a durometer range of 20 to 55, shore 00 scale and having a rebound rate of 1% to 40%. Elastomer #2 to read having a density from .8 to 2.2 and a durometer range from 35 to 70 durometer, shore 00 scale and having a rebound of 5 – 90%.

[REDACTED]

Sincerely,

SORBOTHANE, INC.

Robert E. Boyd
President

REB:djw

cc: JimForsyth

Sorbothane Inc

Innovations in Advanced Polymer Technology

2144 State Rt. 59 • Kent, Ohio 44240 • www.sorbothane.com
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Appendix D



[Redacted]

[Redacted]

Subject: Sorbothane Ultra Sole Spring Gel

Dear [Redacted]

Confirming our conversation, the following is a quote on the new Ultra Sole utilizing a Spring Gel in the forefoot:

[Redacted]

[Redacted] we will be getting some additional samples to you and, bear in mind these are prototypes; as we zero in on the color and coverings, we can produce more sample product accordingly.

Also attached is a listing of potential marketing names for this new Ultra product.

Sincerely,

SORBOTHANE, INC.

Robert E. Boyd
President

Enclosures

Cc: Jim Forsyth
Sue Freilino

Sorbothane Inc.
Advanced Polymer Technology

2144 State Rr. 59 • Kent, Ohio 44240 • www.sorbothane.com
800-838-3906 • Phone (330) 678-9444 • Fax (330) 678-1303

SORBOTHANE
COST ESTIMATE

Quote No.: SORBO ULTRA SOLES
Customer: SORBOTHANE *5 pairs Gel*
Cu. Inch/Part:
Cavities/Mold:
No. of Molds: 38

Part No. _____
Date: _____
Gram: _____
Durometer: _____
Pour/Hour: _____

MATERIALS

Scrap % | 10.0%

Description
SORBOTHANE
FOAM
PORON
SPRING GEL
Total

Description: ULTRA SOLE BULK with Spains Gel in Forefoot

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Appendix E

PICKING TICKET

NUMBER ORDER DATE CUSTOMER NO. CUST. P.O. NO. CUSTOMER TERMS

SHIP-VIA
TSSHIP-DATE SHIPPING INSTRUCTIONS
A.S.A.P.

Sold To:

Ship To:

Qty To Ship	Request Date	Item Number / Description	UoM	Qty Picked
450	07/21/2003	0181810 NRG ULTRA SOLE/RED GEL - A 50 DURO 280 BLUE/280 PORON	EA	_____
900	07/21/2003	0181820 NRG ULTRA SOLE/RED GEL - B 50 DURO 280 BLUE/280 PORON	EA	_____
900	07/21/2003	0181830 NRG ULTRA SOLE/RED GEL - C 50 DURO 280 BLUE/280 PORON	EA	_____
850	07/21/2003	0181840 NRG ULTRA SOLE/RED GEL - D 50 DURO 280 BLUE/280 PORON	EA	_____
1,500	07/21/2003	0181850 NRG ULTRA SOLE/RED GEL- E 50 DURO 280 BLUE/280 PORON	EA	_____
1,400	07/21/2003	0181860 NRG ULTRA SOLE/RED GEL - F 50 DURO 280 BLUE/280 PORON	EA	_____
550	07/21/2003	0181870 NRG ULTRA SOLE/RED GEL - G 50 DURO 280 BLUE/280 PORON	EA	_____
50	07/21/2003	0181880 NRG ULTRA SOLE/RED GEL - H	EA	_____

PICKING TICKET

NUMBER	ORDER DATE	CUSTOMER NO.	CUST. P.O. NO.	CUSTOMER TERMS
[REDACTED]				

HIP-VIA
IPS SHIP-DATE SHIPPING INSTRUCTIONS
A.S.A.P.

d To:

Ship To:

Qty To Ship	Request Date	Item Number / Description	UoM	Qty Picked
450	07/21/2003	0181810 NRG ULTRA SOLE/RED GEL - A 50 DURO 280 BLUE/280 PORON	EA	<i>9</i>
900	07/21/2003	0181820 NRG ULTRA SOLE/RED GEL - B 50 DURO 280 BLUE/280 PORON	EA	<i>8</i>
900	07/21/2003	0181830 NRG ULTRA SOLE/RED GEL - C 50 DURO 280 BLUE/280 PORON	EA	<i>8</i>
850	07/21/2003	0181840 NRG ULTRA SOLE/RED GEL - D 50 DURO 280 BLUE/280 PORON	EA	<i>8</i>
1,500	07/21/2003	0181850 NRG ULTRA SOLE/RED GEL - E 50 DURO 280 BLUE/280 PORON	EA	<i>200</i>
1,400	07/21/2003	0181860 NRG ULTRA SOLE/RED GEL - F 50 DURO 280 BLUE/280 PORON	EA	<i>8</i>
550	07/21/2003	0181870 NRG ULTRA SOLE/RED GEL - G 50 DURO 280 BLUE/280 PORON	EA	<i>8</i>
50	07/21/2003	0181880 NRG ULTRA SOLE/RED GEL - H	EA	<i>8</i>

7/21/03

ORG
lane Inc2144 State Rt. 59 • Kent, Ohio 44240
(330) 678-9444 Fax (330) 678-1303**INVOICE**No. 1010-
1
INVOICE DATE 07/22/03
07/22/03PLEASE REMIT TO: ► TRELLEBORG CORP.
22029 NETWORK PLACE
CHICAGO, IL 60673-1220SOLD
TOSHIP
TO

PO NO.	ORDER DATE	CUSTOMER NO.	LOG	SUPPLY	PURCHASE ORD. NO.	JOB NUMBER	SHIP VIA
	07/21/03		OH	900			UPS

QTY. PO#ER/B.O.	QTY. SHIP/RETURN	ITEM NO./DESCRIPTION	UNIT PRICE	UOM/ DISC.	NET PRICE
450		0181810 NRG ULTRA SOLE/RED GEL - A 50 DURO 280 BLUE/280 PORON		EA	.00
450				EA	
900		0181820 NRG ULTRA SOLE/RED GEL - B 50 DURO 280 BLUE/280 PORON		EA	.00
900				EA	
900		0181830 NRG ULTRA SOLE/RED GEL - C 50 DURO 280 BLUE/280 PORON		EA	.00
900				EA	
850		0181840 NRG ULTRA SOLE/RED GEL - D 50 DURO 280 BLUE/280 PORON		EA	.00
850				EA	
1,500	200	0181850 NRG ULTRA SOLE/RED GEL - E 50 DURO 280 BLUE/280 PORON		EA	
1,300				EA	
1,400		0181860 NRG ULTRA SOLE/RED GEL - F 50 DURO 280 BLUE/280 PORON		EA	.00
1,400				EA	
550		0181870 NRG ULTRA SOLE/RED GEL - G 50 DURO 280 BLUE/280 PORON		EA	.00
550				EA	
50		0181880 NRG ULTRA SOLE/RED GEL - H		EA	.00
50				EA	

COMMENTS	SALE AMOUNT
	MISC. CHARGES FREIGHT SALES TAX TOTAL
TERMS	AMOUNT RECEIVED BALANCE DUE

CUSTOMER SERVICE

PICKING TICKET

NUMBER ORDER DATE CUSTOMER NO. CUST. P.O. NO. CUSTOMER TERMS

P-VIA SHIP-DATE SHIPPING INSTRUCTIONS
A.S.A.P.

To: [REDACTED] Ship To: [REDACTED]

7/31/03

To Ship	Request Date	Item Number / Description	UoM	Qty Picked
450	07/21/2003	0181810 NRG ULTRA SOLE/RED GEL - A 50 DURO 280 BLUE/280 PORON	EA	375
500	07/21/2003	0181820 NRG ULTRA SOLE/RED GEL - B 50 DURO 280 BLUE/280 PORON	EA	425
900	07/21/2003	0181830 NRG ULTRA SOLE/RED GEL - C 50 DURO 280 BLUE/280 PORON	EA	625
350	07/21/2003	0181840 NRG ULTRA SOLE/RED GEL - D 50 DURO 280 BLUE/280 PORON	EA	850
300	07/21/2003	0181850 NRG ULTRA SOLE/RED GEL - E 50 DURO 280 BLUE/280 PORON	EA	900
100	07/21/2003	0181860 NRG ULTRA SOLE/RED GEL - F 50 DURO 280 BLUE/280 PORON	EA	950
150	07/21/2003	0181870 NRG ULTRA SOLE/RED GEL - G 50 DURO 280 BLUE/280 PORON	EA	550
50	07/21/2003	0181880 NRG ULTRA SOLE/RED GEL - H	EA	50

O

Jun. 12, 2001, 2:45PM, Sorbothane

2144 State Rt. 59 • Kent, Ohio 44240
(330) 678-9644 Fax (330) 678-1303

INVOICE

No. 101044P. y
INVOICE DATED 03/

ORG
ne Inc

LEASE REMIT TO: ► TRELLEBORG CORP.
22029 NETWORK PLACE
CHICAGO IL 60673-1220

SHIP
TO

ORDER NO.	ORDER DATE	CUSTOMER	LOC.	ST/MIN	PURCHASE ORD. NO.	JOB NUMBER	SHIP VIA	COMPPD
	07/21/03	[REDACTED]	OH	900	[REDACTED]		UPS	

QTY. ORDER#	QTY. SHIP/RETURN	ITEM NO./DESCRIPTION	UNIT PRICE	UOM DISC.	NET PRICE
450	375	0181810 NRG ULTRA SOLE/RED GEL - A 50 DURO 280 BLUE/280 PORON	[REDACTED]	EA	[REDACTED]
75					
900	425	0181820 NRG ULTRA SOLE/RED GEL - B 50 DURO 280 BLUE/280 PORON	[REDACTED]	EA	[REDACTED]
475					
900	625	0181830 NRG ULTRA SOLE/RED GEL - C 50 DURO 280 BLUE/280 PORON	[REDACTED]	EA	[REDACTED]
275					
850	850	0181840 NRG ULTRA SOLE/RED GEL - D 50 DURO 280 BLUE/280 PORON	[REDACTED]	EA	[REDACTED]
1,300	900	0181850 NRG ULTRA SOLE/RED GEL - E 50 DURO 280 BLUE/280 PORON	[REDACTED]	EA	[REDACTED]
400					
1,400	950	0181860 NRG ULTRA SOLE/RED GEL - F 50 DURO 280 BLUE/280 PORON	[REDACTED]	EA	[REDACTED]
450					
550	550	0181870 NRG ULTRA SOLE/RED GEL - G 50 DURO 280 BLUE/280 PORON	[REDACTED]	EA	[REDACTED]
50	50	0181880 NRG ULTRA SOLE/RED GEL - H	[REDACTED]	EA	[REDACTED]

COMMENTS	SALE AMOUNT	
TERMS	MISC. CHARGES FREIGHT SALES TAX TOTAL AMOUNT RECEIVED BALANCE DUE	
CUSTOMER SERVICE		

DECLARATION UNDER 37 C.F.R. § 1.131

Appln. No. 10/686,353

Docket No. 066491-00007

Appendix F

SAND & SEBOLT
A LEGAL PROFESSIONAL ASSOCIATION

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FAX: (330) 244-1173
E-MAIL: INFO@SANDSEBOLT.COM

PATENT, TRADEMARK, COPYRIGHT LAW
& RELATED LITIGATION

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FREDERICK H. ZOLLINGER, III
LAURA L. BEOGLOS
CLAY H. CUNNINGHAM

MICHAEL SAND
JAMES F. McCARTHY, III
Of Counsel

September 5, 2003

Mr. Robert E. Boyd, President
SORBOTHANE, INC.
2144 State Rt. 59
Kent, OH 44240

Re: U.S. Patent Application
INSOLE HAVING MULTIPLE ENERGY SOURCES
Our File: 2021012US1AP

Dear Bob:

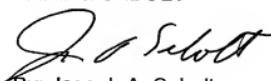
Please review the enclosed patent application for the above-referenced invention.



I look forward to hearing from you. Please call with any questions.

Sincerely,

SAND & SEBOLT


By: Joseph A. Sebolt

JAS/CHC/kab
Enclosures

DECLARATION UNDER 37 C.F.R. § 1.131

Appln. No. 10/686,353

Docket No. 066491-00007

Appendix G

Sorbothane Inc.

Innovations In Advanced Polymer Technology

RECEIVED

OCT 20 2003

SAND & SEBOLT

October 8, 2003

Joseph A. Sebolt
SAND & SEBOLT
Aegis Tower, Suite 1100
4940 Munson Street NW
Canton, OH 44718-3615

Subject: US Patent Application
INSOLE HAVING MULTIPLE ENERGY SOURCES
File No. 2021012US1AP

Dear Joe,



Please submit to the patent office as written.

Sincerely,

SORBOTHANE, INC.



Robert E. Boyd
President

REB:djw

Enclosure